

REMARKS/ARGUMENTS

In response to the Requirement for Restriction and Election pursuant to the Office Action dated January 29, 2010, Applicant elects Group I to claims 1-3, 16, 18, 23, 32-33, and 38-46 drawn to a circulation body. This election is without traverse. Applicant reserves its right to traverse an election requirement in any continuing application to be filed from the present application.

Claims 25, 27 and dependent claims 47-49 have been amended to depend from claims 1 and 2. Claims 44 and 45 have been amended to delete the objectionable language and claims 50-56 have been added since the restriction requirement. It is submitted that the claim amendments and additions resolve Examiner's requirement for restriction and that no new matter is added.

With respect to the Examiner's Note in the office action regarding the negative limitation, negative limitations are not impermissible per se and may be allowed if indefiniteness, undue breadth and obviousness are avoided.¹ A negative limitation may cause a claim to fail: (1) on grounds of indefiniteness, (2) on grounds of undue breadth, or (3) on grounds of obviousness.² Furthermore, it has been held that it is not necessary for the specification to provide *ipsis verbis* (i.e., word for word) support for claim language.³ An imperfect written description will be aided by correct drawings, which are part of the specification.⁴ In *In re Tschop*, the Court of Customs and Patent Appeals notes that the Board of Appeals of the United States Patent Office held that a phrase not appearing in the specification does not constitute new matter.⁵ However, because the claim limitation was in negative

¹ See *In re Wakefield*, 422 F.2d 897, 904 (CCPA 1970) (claim with "negative limitation excluding the characteristics of the prior art products" is "still definite... because each recited limitation is definite;" "synthetic" has "a reasonably precise meaning.").

² See Chisum on Patents §8.06[3].

³ See, e.g., *In re Wertheim* 541 F.2d 257 (CCPA 1976) ("The PTO has done nothing more than to argue lack of literal support, which is not enough. If lack of literal support alone were enough to support a rejection under § 112, then the statement of [In re Lukach, 442 F.2d 967, 969 (CCPA 1971)], that 'the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112,' is empty verbiage. The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.")

⁴ *Thompson v. Dicke*, 110 F.2d 98, 105 (CCPA 1940).

⁵ 139 F.2d 515, 516-517 (CCPA 1943) ("each of the claims describes the nickel anode as 'being substantially devoid of carbon,' and one ground upon which the examiner based rejection of them was that this phrase constituted new matter because it does not appear in the specification. The board, for reasons stated by it, held that the phrase does not constitute new matter, thus reversing that phase of the

form, the Board gave the claim no patentable weight.⁶ The drawings and specification in the present application do not show a clutch and it is respectfully submitted therefore that the negative claim limitation is supported by the originally-filed application.

New claims 53-56 are supported by the original application as well. FIG. 1 and the related disclosure clearly disclose an axial control valve that controls flow through the valve using axial movement. The valve includes a housing with a flow channel connecting an inlet and an outlet. There is also a flow-around body arranged in the flow channel. A flow restrictor in the form of a perforated panel in cylindrical form is located in the flow channel. The valve uses an actuation mechanism in the flow-around body that is coupled to the flow restrictor and actuates in an axial direction to adjust the exposure of the holes in the perforated panel. Doing so varies the flow rate through the valve as more exposure of the holes increases flow rate and less exposure decreases flow rate. It is respectfully submitted therefore that claims 53-56 are fully supported by FIG. 1 and the related description.

Claims 53-56 have not been made subject to a restriction requirement and it is submitted that they are related to the other pending claims and not in need of restriction. However, should Examiner feel the need to further restrict the claims, Examiner is invited to contact the undersigned to discuss an election without the need to issue a further Action.

CONCLUSION

If the Examiner feels it would be advantageous, he is encouraged to telephone the undersigned at (713) 238-8080. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore. If any fee is due, please appropriately charge such fee to Deposit Account Number 03-0335 of Cameron International Corporation., Houston, Texas.

Respectfully submitted,

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examiner's decision, but added: 'However, the phrase is purely negative and can be given no patentable weight. In our opinion it is immaterial whether this phrase remains in the claims or not.'")

⁶ *Id.* (this case was decided before negative limitations came out of disfavor among courts).